



Appeal Brief Under 37 C.F.R. § 41.37
Attorney Docket No.: 019213-0311422
Application Serial No.: 09/732,008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT(S) : Paul H. ROBB CONFIRMATION NO.: 1665
SERIAL NUMBER : 09/732,008 EXAMINER: Kelly Scaggs Campen
FILING DATE : December 8, 2000 ART UNIT: 3624
FOR : METHOD AND SYSTEM FOR COLLABORATING ADVISORS

Appeal Brief Under 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on **September 11, 2006**, Appellant submits this Brief on Appeal pursuant to 37 C.F.R. § 41.37.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary, then the Director is further authorized to charge any additional fees that may be due, or credit any overpayment of the same to our Deposit Account No. 033975 (**Ref. No. 019213-0311422**).

01/12/2007 JADD01 00000031 033975 09732008
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Appeal Brief Under 37 C.F.R. § 41.37

I. Real Party in Interest

Collaborate Solutions Inc., the assignee of the present application, is the real party in interest.

II. Related Appeals and Interferences

A related appeal is pending before the Board of Patent Appeals and Interferences ("Board") in copending U.S. Patent Application Ser. No. 09/877,926. No decisions have been rendered by the Board in the pending appeal.

III. Status of Claims

Pending: Claims 1-55 are pending.

Cancelled: No claims have been cancelled.

Rejected: Claims 1-41 stand rejected.

Withdrawn: Claims 42-55 have been withdrawn from consideration as allegedly being directed to a non-elected invention.

Allowed: No claims have been allowed.

On Appeal: Claims 1-41 are appealed.

IV. Status of Amendments

An After-Final Amendment was filed on July 10, 2006, making amendments to the Abstract. The amendment was entered in the Advisory Action mailed August 23, 2006.

V. Summary of Claimed Subject Matter

The invention is directed to a system and method for providing a common collaboration tool, where a services client and one or more authorized advisors can work together online. For example, a financial services client may have various advisors, including tax advisors, accounts advisors, investment advisors, wills and estates advisors, personal finance advisors, or others. In certain instances, a client's advisors may require knowledge of changes to a client's financial situation based on action taken by other

advisors. For example, when the client makes investment decisions, those decisions may impact the client's taxes, estates, personal finances, or other areas.

Furthermore, in some instances, one or more advisors may need to collaborate among themselves to provide services to the common client. For example, a client may want to make changes to an investment portfolio, and an investment advisor may need to collaborate with a personal finance advisor, real estate advisor, or other advisor for various reasons (e.g., to make funds available, to assess risk allocation, etc.).

Accordingly, the collaboration tool of the invention may enable a client and/or an advisor to be authorized to access the client's data, among other things. The authorization can be granted at different levels (e.g., access may be granted for all documents, specific documents, or otherwise). Further, advisors or other participants may use the tool to interact and collaborate as a cohesive team in sharing information, devising plans, addressing client concerns, drafting or modifying documents, or performing other services on behalf of the client in a secure and convenient manner, even if the advisors work for different companies or organizations. Moreover, the tool has broad applicability, and may enable collaboration among a client and financial advisors, medical advisors, educational advisors, or others.

The following exemplary citations to the Specification and/or drawing figures are not exclusive, as other examples of support for claimed subject matter exist. As such, the following citations should not be viewed as limiting.

Independent Claim 1

Claim 1 recites a computer implemented method for providing an electronic collaboration tool with which a financial services client and one or more financial services provider participants may interact. *See, e.g.*, Specification at 4, lines 2-4.

One or more participants be authorized to access client data. *See, e.g.*, Specification at 4, lines 5-8.

A client or participant may submit client data to the electronic collaboration tool. *See, e.g.*, Specification at 4, lines 10-15; 8, lines 7-11.

The client may submit one or more requests for one or more services to the electronic collaboration tool. *See, e.g.*, Specification at 12, lines 15-17.

As such, the client may interact with one or more financial service provider participants through the electronic collaboration tool (*See, e.g.*, Specification at 9, lines 1-9), wherein the electronic collaboration tool further enables interaction among participants (*See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7), wherein interaction comprises exchange of client data. *See, e.g.*, Specification at 15, line 2 – 17, line 7; 19, lines 4-11.

Independent Claim 11

Claim 11 recites a computer implemented method for providing an electronic collaboration tool with which one or more financial service provider participants may collaborate with each other. *See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7.

The method may include the one or more participants receiving authorization by a client to access client data. *See, e.g.*, Specification at 4, lines 5-8.

The one or more financial service provider participants may access the collaboration tool (*See, e.g.*, Specification at 14, line 10 – 15, line 1), where the tool may be used for the client and one or more financial service provider participants to interact (*See, e.g.*, Specification at 9, lines 1-9), and/or for the financial service provider participants to interact with each other (*See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7), wherein client data may be exchanged (*See, e.g.*, Specification at 15, line 2 – 17, line 7; 19, lines 4-11).

Furthermore, the one or more financial service provider participants may access client data, as authorized by the client. *See, e.g.*, Specification at 12, lines 10-13.

Independent Claim 20

Claim 20 recites a computer implemented system for providing an electronic collaboration tool with which a financial services client and one or more financial service provider participants may interact. *See, e.g.*, Specification at 4, lines 2-4.

Authorization means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable authorization of one or more financial service provider participants to access client data (*See, e.g.*, Specification at 12, lines 10-13).

Data means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable a client or participant to submit client data to the electronic collaboration tool (*See, e.g.*, Specification at 4, lines 10-15; 8, lines 7-11).

Request means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable the client to submit one or more requests for one or more services to the collaboration tool (*See, e.g.*, Specification at 12, lines 15-17).

Interaction means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable the client to interact with one or more financial service provider participants through the collaboration tool (*See, e.g.*, Specification at 9, lines 1-9), wherein the collaboration tool may further enable interaction among participants (*See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7), wherein interaction comprises exchange of client data (*See, e.g.*, Specification at 15, line 2 – 17, line 7; 19, lines 4-11).

Independent Claim 30

Claim 30 recites a computer implemented system for providing a collaboration tool with which one or more participants may collaborate with each other. *See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7.

The system may include authorization means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) for enabling the one or more participants to receive authorization by a client to access client data (*See, e.g.*, Specification at 4, lines 5-8).

Access means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable the one or more participants to access the collaboration tool (*See, e.g.*, Specification at 14, line 10 – 15, line 1), where the collaboration tool may enable the client to interact with one or more participants (*See, e.g.*, Specification at 9, lines 1-9), and the participants may interact with each other (*See, e.g.*, Specification at 15, lines 2-6; 17, lines 2-7), wherein client data may be exchanged (*See, e.g.*, Specification at 15, line 2 – 17, line 7; 19, lines 4-11).

Data means (*See, e.g.*, Specification at 22, line 3 – 23, line 5) may enable one or more participants to access client data, as authorized by the client (*See, e.g.*, Specification at 12, lines 10-13).

Independent Claim 39

Claim 39 recites a computer implemented method for providing a collaboration tool with which a client of more than one financial services advisor and one or more financial services advisor participants may interact. *See, e.g.*, Specification at 4, lines 2-4.

The method may include enabling a client of more than one financial services advisor to submit personal and financial data to the collaboration tool. *See, e.g.*, Specification at 4, lines 10-15; 8, lines 7-11.

The client may authorize one or more financial services advisor participants to access personal and financial data about the client. *See, e.g.*, Specification at 12, lines 10-13

The client may submit one or more requests for one or more services to the collaboration tool. *See, e.g.*, Specification at 12, lines 15-17.

The collaboration tool may include a client module that enables the client to access data associated with the client (*See, e.g.*, Specification at 12, line 14 – 13, line 5) and define data level access control for one or more financial services advisors (*See, e.g.*, Specification at 12, lines 10-13).

The collaboration tool may include an advisor module that enables one or more financial services advisors to select a client for which the client has previously granted the financial services advisor access to that clients data (*See, e.g.*, Specification at 14, lines 10-15), and to select an activity related to the selected client (*See, e.g.*, Specification at 14, line 15 – 15, line 1).

The collaboration tool may include a client history database that stores data related to the client and records activity associated with the client. *See, e.g.*, Specification at 9, lines 10-21.

The collaboration tool may include a collaboration module that enables a client and one or more authorized financial services advisors to communicate online. *See, e.g.*, Specification at 15, line 2 – 17, line 7.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1-41 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 1-7, 9-17, 19-26, 28-36, and 38-40 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich et al. (“Zucknovich”).

Claims 8, 18, 27, 37, and 41 stand rejected under § 103 as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,243,722 to Day et al. ("Day").

Appellant notes the provisional rejection of claims 1-37 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-56 of copending Application No. 09/877,926.

Although Appellant disagrees with the provisional double-patenting rejections set forth by the Examiner, Appellant will not address these provisional rejections in the Appeal Brief. Rather, Appellant will file a terminal disclaimer upon the indication of allowable subject matter, to the extent necessary. Appellant further notes that no claims have been indicated as allowable in copending Application No. 09/877,926, and that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991) ("filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.").

VII. Argument

A. The rejections of claims 1-41 under § 112, second paragraph, should be reversed because the claims are clear and definite.

Claims 1-41 stand rejected under § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

More particularly, in the Final Office Action mailed March 9, 2006 ("Final Action") the Examiner alleges, "there is no clear definition of the meets [*sic*] and bounds" for the following claim terms: "collaborate," "enabling," "to interact," "events," and "actions." Final Action at 3. The Examiner also alleges that the "terms 'clients' and 'participants' are confusing since the relationship between the two is not recited." *Id.* The Examiner also alleges that claims 20-38 are indefinite because a "system" is "vague and indefinite since a system may be one of several statutory classes of invention." *Id.* at 4.

This rejection is legally improper and should be reversed because the claims meet the statutory requirements of clarity and precision required under § 112, second paragraph.

1. The § 112 rejection is legally improper because the allegedly undefined claim terms have a readily discernable plain meaning, and are clearly described in the Specification.

The Examiner alleges, “there is no clear definition of the meets [*sic*] and bounds” for the following claim terms: “collaborate,” “enabling,” “to interact,” “events,” and “actions.” Final Action at 3. Each of these terms are fairly common terms, and should be well understood alone, or clearly in the context of the Specification. Even if it were true that these are not commonly understood terms, they are not indefinite, as Appellant is entitled to act as its own lexicographer, and can claim the invention in whatever terms it chooses.

A claim cannot be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. *In re Swinehart*, 439 F.2d 210, 213, 160 U.S.P.Q. 226 (C.C.P.A. 1971). Rather, the only grounds available for rejecting a claim under § 112 are when “the language used is not precise and definite enough to provide a clear-cut indication of the scope of the subject matter embraced by the claim,” or when “the language is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure.” *Id.* Neither of those grounds apply to the claimed invention, and therefore, the claim meets the threshold requirements of clarity and precision required § 112, second paragraph. For at least this reason, the rejections under § 112, second paragraph are legally improper and should be reversed.

Although Appellants submit that the claims are sufficiently clear on their face, exemplary citations to the Specification have been provided to further demonstrate that the scope of the challenged claim terms would be discernable to a person having ordinary skill in the art. The following recitations and citations to the Specification are exemplary only and should not be viewed as limiting.

A team of advisors and clients may “collaborate” as a cohesive team and work together to at least some degree, for example by sharing information, devising a plan, addressing client concerns, drafting or modifying documents, and/or performing other collaborative tasks.¹ See, e.g., Specification at 4, lines 5-15.

¹ For example, it is common for a client to have several financial advisors with distinct specialties.

A client (or other participants) may be “enabled” to authorize selected advisors (or other participants) to view, discuss, modify, and perform other tasks. *See, e.g.*, Specification at 4, lines 5-7; 5, lines 5-7; 5, lines 10-12. For example, the client (or other participants) may grant rights (e.g., grant rights to access certain documents, types of documents, etc.), “enabling” that entity to view or interact with the document. *See, e.g.*, Specification at 12, lines 10-13.

Clients, advisors, and/or other participants may “interact” with clients in a variety of ways, for example, by using a collaboration tool to communicate with each other and/or the client, and otherwise serve the client in a coordinated manner. *See, e.g.*, Specification at 15, lines 2-5; 15, line 19 – 16, line 3; 17, lines 2-7.

Clients (or other participants) may define personalized alerts for defining “events,” where a notification may be sent in response to a particular action. *See, e.g.*, Specification at 13, line 16 – 14, line 5; 17, lines 15-19.

An advisor, client, or other participant may perform an “action” by viewing, editing, or performing other operations. Specification at 13, lines 16-18; 14, lines 15-20.

Appellant’s have previously pointed out the flaws in this rejection, and have provided citations to the Specification to clearly convey to the Examiner the meaning of the claim terms. However, the Examiner responds by alleging that “what may considered such to one may not be considered such to another.” Final Action at 6. What this means and how the Examiner believes this to be legally significant is a mystery. Furthermore, the Examiner alleges that the standard for claim interpretation is to give claim terms “the broadest possible meaning.” *Id.* This both mistakes the law and is largely irrelevant to a § 112, second paragraph analysis. The question is not how broad or narrow the claims should be interpreted, but rather, whether the claims are clear and definite.

When determining the scope of the claims, the Patent and Trademark Office is to interpret the claims in accordance with “their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Philips v.*

However, the roles of the various financial advisors are likely to overlap to some extent, wherein they may consider similar financial data or may provide advice based on implications of the actions of other advisors. The collaboration tool of the invention thus provides a solution for teams of advisors to work together for a common client by sharing resources and information, as well as facilitating communication amongst distinct entities. For example, what a trust and estate attorney may do for a client may

AWH Corp., 415 F.3d 1303, 1316, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005). By failing to consider the recitations of the claim terms in light of the specification, the Examiner is using the incorrect legal standard for claim interpretation.

For at least the reason that a person having ordinary skill in the art would be able to identify the meaning of the claim terms, particularly when viewed in light of the Specification, the claim terms are clear and definite. For at least this reason, the rejection under § 112, second paragraph, is legally improper and should be reversed.

2. The § 112 rejection is legally improper because the relationship among the allegedly confusing claim terms is readily discernable, especially in light of the Specification.

The Examiner alleges that the “terms ‘clients’ and ‘participants’ are confusing since the relationship between the two is not recited.” Final Action at 3. This allegation is without merit and legally improper. For example, referring to claim 1, it is clearly recited that “a financial services client and one or more financial service provider participants may interact” using the “electronic collaboration tool.” The relationship between “clients” and financial service provider “participants” as used therein is clear from the plain language of the claim. It is well known what a financial service provider is, and that the entities they provide services to are often referred to as clients.

For at least the reason that the claims sufficiently recite the relationship between “clients” and “participants,” the claims are clear and definite. For at least this reason, the rejection under § 112, second paragraph, is legally improper and should be reversed.

3. The § 112 rejection is legally improper because “system” claims are routinely used in patent claims without rejection, and there is no basis for alleging that a “system” may span multiple statutory classes of invention.

The Examiner alleges that claims 20-38 are indefinite because a “system” is “vague and indefinite since a system may be one of several statutory classes of invention.” Final Action at 4. Moreover, the Examiner alleges, “Applicant must indicate on the record what statutory class of invention the system claims belong to.” *Id.*

This rejection is without proper basis and is legally improper. The term “system” is routinely used in patent claims without rejection, and no legal basis has been provided for this position. Even if the system of claims 20-38 are interpreted as functional limitations,

implicate a need for the client’s tax advisor to participate in the planning.

“there is nothing intrinsically wrong” with claiming something “by what it does rather than what it is.” *Swinehart*, 439 F.2d at 212, 160 U.S.P.Q. at 226. The system claims (i.e., claims 20-38) are intrinsically clear on their face, and the Examiner’s basis for the rejection is legally improper. Furthermore, Appellants have argued the impropriety of this rejection in several responses (*See, e.g.*, Response dated December 13, 2005 at 17; Response dated July 10, 2006 at 17). However, the Examiner continues to assert the rejection without providing a proper legal basis for alleging indefiniteness.

For at least the reason that a person having ordinary skill in the art would be able to identify the boundaries of claims 20-38, including the relevant statutory class of invention, the claims are clear and definite. For at least this reason, the rejections under § 112, second paragraph, are legally improper and should be reversed.

B. The rejections of claims 1-41 under § 103 should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 1-7, 9-17, 19-26, 28-36, and 38-40 stand rejected under § 103 as allegedly being unpatentable over Zucknovich; claims 8, 18, 27, 37, and 41 stand rejected under § 103 as allegedly being unpatentable over Zucknovich in view of Day.

In order to establish a *prima facie* case of obviousness, among other things, the references relied upon, either individually or when combined, must disclose, teach, or suggest every feature of the claimed invention. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The Examiner has failed to meet this burden because the references relied upon, either alone or in combination, fail to disclose, teach, or suggest all the features of the claimed invention. Furthermore, Zucknovich is nonanalogous art, and thus cannot be relied upon as the basis for an obviousness rejection. For at least these reasons, the § 103 are legally improper, and should be reversed.

1. Zucknovich and Day, either alone or in combination, fail to disclose, teach, or suggest every feature of the claimed invention.

Zucknovich fails to disclose, teach, or suggest at least the feature of “enabling the client to interact with one or more financial service provider participants through the electronic collaboration tool wherein the electronic collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data,” as recited in claim 1, for example. The Examiner appears to rely upon Zucknovich at col. 5,

lines 60-67 as teaching the claimed “client” and “client data,” and col. 7, lines 14-50; col. 8, lines 14-50 as teaching the claimed “interaction among participants wherein interaction comprises exchange of client data.” Non-Final Office Action mailed July 13, 2005 (“Non-Final Action”) at 6.

Zucknovich is fundamentally different, and addresses different problems from that of the claimed invention. Zucknovich generally relates to research contributors and reports generated by the research contributors, wherein the reports are distributed to investors.² The cited portions of Zucknovich do not relate to “an electronic collaboration tool . . . enabling the client to interact with one or more financial service provider participants . . . through the electronic collaboration tool wherein the electronic collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data.”

In particular, the research reports identified by the Examiner cannot be reasonably considered “client data,” as the claimed invention recites enabling collaboration between clients and participants by authorizing participants to access “client data.” The “client data” recited in claim 1 is specific to a client, and participants may be granted authorization to access the client data, thereby enabling interaction amongst the various entities.

Assuming *arguendo* that the research contributors and investors described in Zucknovich can be considered similar to the claimed “clients” and “participants,” the content of the research reports concerns third parties, rather than the investors or research contributors. Because the content of the reports describe neither the research contributors nor the recipients of the report, the distribution of reports cannot be reasonably considered “exchange of client data.” This is clear from the Background of Zucknovich, which describes third party financial research firms, which deliver information regarding public companies to investors. That is, the content of the research pertains to third parties, and thus the distribution and regulation of access is not “exchange of client data,” as alleged by the Examiner.

² Whereas the claimed invention recites collaboration between a financial services clients and one or more financial services provider participants, Zucknovich is directed to distributing research reports to a central repository, and regulating access to the reports. There is no collaboration between the research contributors and the recipients of the reports, nor do the research contributors collaborate with each other on behalf of a common client. Further, the information in the reports do not appear to relate to

Furthermore, the cited passages of Zucknovich merely describe an investor logging into a web site to download research reports (i.e., there is no “interaction” between parties in Zucknovich). Zucknovich teaches research contributors independently generating research reports, and submitting the reports to a central repository (col. 5, lines 59-65; col. 6, lines 17-39; col. 6, lines 60-67). The research contributors generate the reports independently of any specific client investor, and the contributor’s role is complete after the report is submitted to the repository. Moreover, investors may subsequently log into the web site to download the reports (col. 7, lines 48-61; col. 8, lines 15-62), but this is not the same as an interaction “with one or more financial service provider participants through the electronic collaboration tool.”

At best, Zucknovich teaches research contributors and investors independently interacting with a data repository. However, Zucknovich does not disclose, teach, or suggest “interaction” between the investors and contributors, whereas claim 1 recites “the client [interacting] with one or more financial service provider participants” or “interaction among participants wherein interaction comprises exchange of client data.”

The Examiner acknowledges that Zucknovich does not disclose, teach, or suggest a collaboration tool, but nonetheless alleges that such a teaching would have been obvious because Zucknovich allegedly teaches “that research provides require interaction with those who desire their work product.” Final Action at 7. The Examiner appears to identify col. 1, lines 39-44 as support for this allegation. *Id.*

The Examiner’s assertion is factually incorrect, and fails to establish obviousness, because the cited portions of Zucknovich do not discuss interaction between research providers and those who access their work product and are woefully deficient in providing a legal basis for alleging obviousness. Rather, the cited passages address controlling access to research reports. At best, regulating access to the reports is a security measure rather than interaction.

For at least the foregoing reasons, Zucknovich does not disclose, teach, or suggest every feature of claim 1. For example, Zucknovich fails to disclose, teach, or suggest at least the feature of “enabling the client to interact with one or more financial service provider participants through the electronic collaboration tool wherein the electronic collaboration

the client or the participants, but rather, to third-parties.

tool further enables interaction among participants wherein interaction comprises exchange of client data,” as recited in claim 1. For at least this reason, the rejection of claim 1 is improper.

Claims 11, 20, 30, and 40 recite similar features as those recited in claim 1. Claims 2-7, 9-10, 12-17, 19, 21-26, 28-29, 31-36, and 38-39 depend from and add features to one of claims 1, 11, 20, and 30. Thus, the rejection of claims 1-7, 9-17, 19-26, 28-36, and 38-40 under § 103 as allegedly being unpatentable over Zucknovich are legally improper and should be reversed. Furthermore, Day fails to cure the deficiencies of Zucknovich discussed above. Thus, the rejection of claims 8, 18, 27, 37, and 41 under § 103 as allegedly being unpatentable over Zucknovich in view of Day are legally improper and should be reversed for at least the same reasons.

In addition, the Examiner applied a blanket rejection for many of the dependent claims, and has failed to provide adequate evidence in support of the rejections. See Non-Final Action at 6-7.

For example, Zucknovich and Day, either alone or in combination, fail to disclose, teach, or suggest “enabling the client to define the scope of authorization for each participant,”³ as recited in claims 4, 14, 23, and 33, for example.

Zucknovich and Day, either alone or in combination, also fail to disclose, teach, or suggest that “client data comprises client work product wherein client work product comprises one or more documents, strategies, ideas, plans, correspondences and communications,” as recited in claims 7, 17, 26, and 36, for example.

Zucknovich and Day, either alone or in combination, also fail to disclose, teach, or suggest “enabling the client to view participant input wherein participant input comprises one or more of edits, analysis and comments related to client data,” as recited in claims 8, 18, 27, and 37, for example.

Zucknovich and Day, either alone or in combination, also fail to disclose, teach, or suggest “enabling the client to define one or more triggering events and one or more alert

³ For example, certain financial advisors may only need access to certain documents, and the collaboration tool of the invention enables clients (or other participants) to define what a particular advisor (or set of advisors) is authorized to modify. The collaboration tool may provide a forum to store any number of client documents or other data, and each advisor may be authorized to view some or all of the documents or data as needed for that advisor’s tasks and responsibilities.

mechanisms for notifying the client of the occurrence of the one or more triggering events,” as recited in claims 9, 28, and 40, for example.

Zucknovich and Day, either alone or in combination, also fail to disclose, teach, or suggest “enabling the client to access a client history database wherein the client history database maintains information related to previous updates,” as recited in claims 10, 19, 29, and 38, for example.

Therefore, the rejections of these claims are likewise improper and should be reversed for at least the same reasons.

2. The rejections of claims 1-41 under § 103 should be reversed because Zucknovich is nonanalogous art.

In addition to failing to disclose, teach, or suggest several features of the claimed invention, the Examiner has failed to meet the burden of establishing Zucknovich (the primary reference in all of the § 103 rejections) as analogous art. More particularly, “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).

Zucknovich’s field of endeavor relates to research providers electronically distributing opinions and reports to recipients (col. 1, lines 5-10). By contrast, the field of endeavor of the claimed invention relates to providing client-specific services and advice through collaboration among clients and their advisors or other participants. Furthermore, the particular problem addressed by Zucknovich relates to enabling research providers to control access to their opinions and reports, or to indicate that a company is under review (col. 1, line 39 – col. 2, line 14). By contrast, the particular problem addressed by the claimed invention relates to enabling an exchange of client data among various authorized entities, thereby providing consistent, accurate, and secure collaboration using client data, shared resources, and/or other information.

For at least the foregoing reasons, Zucknovich is neither in Appellant’s field of endeavor nor reasonably pertinent to the particular problem with which Appellant was concerned. As such, Zucknovich is nonanalogous art, and each rejection based thereon must fail.

In response to previous arguments addressing this issue, the Examiner responded by alleging that Zucknovich “is both in the field of applicant’s endeavor and is reasonable [*sic*] pertinent to the particular problem with which the applicant is concerned.” Final Action at 7. The Examiner’s allegation is broad and conclusory, and the Examiner has not provided any evidence to support the allegation of Zucknovich being in Appellant’s field of endeavor or reasonably pertinent to the problem addressed by Appellant. For at least these reasons, the Examiner has failed to meet the burden of establish that Zucknovich is analogous art.

VIII. Claims Appendix

The pending claims (claims 1-55) are attached in **Appendix A**.

IX. Evidence Appendix

Appendix B: None.

X. Related Proceedings Appendix

Appendix C: None.

Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the present claims are clear and definite, as well as being allowable over the cited prior art references. Reversal of the rejections is respectfully requested.

Date: January 11, 2007

Respectfully submitted,

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Appendix A: Claims Appendix

1. **(Previously Presented)** A computer implemented method for providing an electronic collaboration tool with which a financial services client and one or more financial services provider participants may interact comprising the steps of:
 - a) enabling authorization of one or more participants to access client data;
 - b) enabling a client or participant to submit client data to the electronic collaboration tool;
 - c) enabling the client to submit one or more requests for one or more services to the electronic collaboration tool;
 - d) enabling the client to interact with one or more financial service provider participants through the electronic collaboration tool wherein the electronic collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data.
2. **(Original)** The method of claim 1 wherein participants comprise advisors.
3. **(Original)** The method of claim 1 wherein participants comprise one or more entities authorized by the client to participate in the collaboration tool.
4. **(Original)** The method of claim 1 further comprising the step of e) enabling the client to define the scope of authorization for each participant.
5. **(Original)** The method of claim 1 wherein client data comprises financial documents.
6. **(Original)** The method of claim 1 wherein participants comprise financial advisors associated with the client.
7. **(Original)** The method of claim 1 wherein client data comprises client work product wherein client work product comprises one or more documents, strategies, ideas, plans, correspondences and communications.

8. **(Original)** The method of claim 1 further comprising the step of f) enabling the client to view participant input wherein participant input comprises one or more of edits, analysis and comments related to client data.
9. **(Original)** The method of claim 1 further comprising a step of g) enabling the client to define one or more triggering events and one or more alert mechanisms for notifying the client of the occurrence of the one or more triggering events.
10. **(Original)** The method of claim 1 further comprising a step h) enabling the client to access a client history database wherein the client history database maintains information related to previous updates.
11. **(Previously Presented)** A computer implemented method for providing an electronic collaboration tool with which one or more financial service provider participants may collaborate with each other comprising the steps of:
- a) enabling the one or more participants to receive authorization by a client to access client data;
 - b) enabling the one or more financial service provider participants to access the collaboration tool where the collaboration tool enables the client to interact with one or more financial service provider participants and enables the financial service provider participants to interact with each other wherein client data is exchanged; and
 - c) enabling the one or more financial service provider participants to access client data, as authorized by the client.
12. **(Original)** The method of claim 11 wherein participants comprise advisors.
13. **(Original)** The method of claim 11 wherein participants comprise one or more entity authorized by the client to participate in the collaboration tool.

14. **(Original)** The method of claim 11 further comprising the step of enabling the client to define the scope of authorization for each participant.
15. **(Original)** The method of claim 11 wherein client data comprises financial documents.
16. **(Original)** The method of claim 11 wherein participants comprise financial advisors associated with the client.
17. **(Original)** The method of claim 11 wherein the client data comprises client work product wherein client work product comprises one or more of documents, strategies, ideas, plans, correspondences and communications.
18. **(Original)** The method of claim 11 further enabling the participant to provide participant input wherein participant input comprises one or more edits, analysis and comments related to client data.
19. **(Original)** The method of claim 11 wherein participant activity is stored in a history database.
20. **(Previously Presented)** A computer implemented system for providing an electronic collaboration tool with which a financial services client and one or more financial service provider participants may interact comprising:
 - a) authorization means for enabling authorization of one or more financial service provider participants to access client data;
 - b) data means for enabling a client or participant to submit client data to the electronic collaboration tool;
 - c) request means for enabling the client to submit one or more requests for one or more services to the collaboration tool; and
 - d) interaction means for enabling the client to interact with one or more financial service provider participants through the collaboration tool wherein the

collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data.

21. **(Original)** The system of claim 20 wherein participants comprise advisors.
22. **(Original)** The system of claim 20 wherein participants comprise one or more entities authorized by the client to participate in the collaboration tool.
23. **(Original)** The system of claim 20 further comprising scope means for enabling the client to define the scope of authorization for each participant.
24. **(Original)** The system of claim 20 wherein client data comprises financial documents.
25. **(Original)** The system of claim 20 wherein participants comprise financial advisors associated with the client.
26. **(Original)** The system of claim 20 wherein client data comprises client work product wherein client work product comprises one or more of documents, strategies, ideas, plans, correspondences and communications.
27. **(Original)** The system of claim 20 further comprising the view means for enabling the client to view participant input wherein participant input comprises one or more of edits, analysis and comments related to client data.
28. **(Original)** The system of claim 20 further comprising alert means for enabling the client to define one or more triggering events and one or more alert mechanisms for notifying the client of the occurrence of the one or more triggering events.
29. **(Original)** The system of claim 20 further comprising a history database for storing information related to previous updates.

30. **(Previously Presented)** A computer implemented system for providing a collaboration tool with which one or more participants may collaborate with each other comprising:

a) authorization means for enabling the one or more participants to receive authorization by a client to access client data;

b) access means for enabling the one or more participants to access the collaboration tool where the collaboration tool enables the client to interact with one or more participants and enables the participants to interact with each other wherein client data is exchanged; and

c) data means for enabling one or more participants to access client data, as authorized by the client.

31. **(Original)** The system of claim 30 wherein participants comprise advisors.

32. **(Original)** The system of claim 30 wherein participants comprise one or more entity authorized by the client to participant in the collaboration tool.

33. **(Original)** The system of claim 30 further comprising scope means for enabling the client to define the scope of authorization for each participant.

34. **(Original)** The system of claim 30 wherein client data comprises financial documents.

35. **(Original)** The system of claim 30 wherein participants comprise financial advisors associated with the client.

36. **(Original)** The system of claim 30 wherein client data comprises client work product wherein client work product comprises one or more of documents, strategies, ideas, plans, correspondences and communications.

37. **(Original)** The system of claim 30 further comprising input means for enabling the participant to provide participant input wherein participant input comprises one or more of edits, analysis and comments related to client data.

38. **(Original)** The system of claim 30 wherein participant activity is stored in a history database.

39. **(Previously Presented)** A computer implemented method for providing a collaboration tool with which a client of more than one financial services advisor and one or more financial services advisor participants may interact comprising the steps of:

enabling a client of more than one financial services advisor to submit personal and financial data to the collaboration tool;

enabling the client to authorize one or more financial services advisor participants to access personal and financial data about the client;

enabling the client to submit one or more requests for one or more services to the collaboration tool, wherein the collaboration tool further comprises:

a client module that enables the client to access data associated with the client and define data level access control for one or more financial services advisors;

an advisor module that enables one or more financial services advisors to select a client for which the client has previously granted the financial services advisor access to that clients data, and to select an activity related to the selected client;

a client history database that stores data related to the client and records activity associated with the client; and

a collaboration module that enables a client and one or more authorized financial services advisors to communicate online.

40. **(Previously Presented)** The computer implemented method of claim 39 wherein the client module further comprises:

an action request module that enables a client to request one or more financial services advisors to update one or more of the client's files; and

a program alert module that enables the client to define personalized alerts in response to triggering events defined by the client.

41. **(Previously Presented)** The computer implemented method of claim 39 wherein the collaboration module further comprises:

a document view module that enables a client and one or more authorized financial services advisors to view and edit one or more documents related to the client that are stored in a central repository;

an update module that enables the client and one or more financial services advisors to view a summary of modifications performed relative to one or more documents; and

a chat board that enables the client and one or more financial services advisors to engage in a real time online conference.

42. **(Withdrawn)** A computer-implemented online collaboration system for enabling an individual client and a team of financial services advisors, which are associated with the individual client through the system, to communicate and share client specific information online, the system comprising:

a central repository for storing individual client profile information and individual client specific documents;

means for associating, through the system, one or more financial service advisors with an individual client;

an authorization module for authorizing selected financial advisors associated with the individual client to access some or all of the client information and client specific documents, based on the advisor's level of authorization;

a client module for enabling the individual client to interact with the system, the client module comprising:

i) means for electronically presenting to the individual client, via a client interface, individual client specific information, including: a) individual client profile

information relating to the individual client; b) financial services advisor information relating to financial service advisors, associated through the system, with the individual client; and c) individual client account information relating to one or more financial accounts associated with the individual client;

ii) a report module for enabling the individual client to access financial reports relating to the individual client;

iii) a client data input module for enabling the individual client to input information to the system; and

iv) a client document module for enabling the individual client to: a) upload documents to the central repository; and b) access individual client specific documents stored in the central repository; and

an advisor module for enabling financial services advisors to interact with the system, the advisor module comprising:

i) means for electronically presenting to an advisor, via an advisor interface, individual client specific information for an individual client with which the advisor is associated through the system, including: a) individual client profile information relating to the individual client; b) financial services advisor information relating to other financial service advisors, associated through the system, with the individual client; and c) client account information relating to one or more financial accounts associated with the individual client; and

ii) an advisor document module for enabling the advisor to: a) upload documents to the central repository; and b) access via the central repository, individual client specific documents, for an individual client with which the advisor is associated through the system.

43. **(Withdrawn)** The system of claim 42 further comprising means for monitoring an individual client's financial assets and an alert module for issuing alerts to selected financial advisors associated with the individual client when predetermined alert conditions are satisfied.

44. **(Withdrawn)** The system of claim 42 further comprising an audit module for auditing activities performed on behalf of an individual client.

45. **(Withdrawn)** The system of claim 42 further comprising client history module for tracking, via the system, activity relating to an individual client.

46. **(Withdrawn)** The system of claim 42 further comprising client history module for tracking, via the system, individual advisor's activity relating to an individual client.

47. **(Withdrawn)** The system of claim 42 wherein the client data input module is operable to:

a) receive client specific data from an individual client once; and

b) enable each or some of authorized financial advisors associated with the individual client to access the client specific data to avoid the need for an individual client to repetitively provide the same client specific data to financial service providers.

48. **(Withdrawn)** The system of claim 42 further comprising a security module for requiring financial service providers and an individual client to log-in and provide a password to access the system, and further comprising means for customizing the presentation of service options available to a financial services provider based on requirements and a level of authorization.

49. **(Withdrawn)** The system of claim 42 further comprising a security module for requiring financial service providers to log-in and provide a password to access the system, and further comprising means for customizing a financial service provider's access to functions and data for which the financial service provider has a need.

50. **(Withdrawn)** The system of claim 42 further comprising a communication module for enabling financial service providers and an individual client to securely communicate through the system.

51. **(Withdrawn)** The system of claim 42 further comprising a financial planning tool module integrated within the system for enabling financial service providers to provide financial advice to an individual client using the financial planning tools module and the individual client information stored in the central repository, without the need for manually reentering the individual client information.

52. **(Withdrawn)** The system of claim 42 further comprising a communication module for enabling financial service providers and an individual client to securely, simultaneously view documents online through the system.

53. **(Withdrawn)** The system of claim 42 further comprising a communication module for enabling financial service providers and an individual client to securely, simultaneously view individual client specific information through the system.

54. **(Withdrawn)** The system of claim 42 further comprising means for adding, through the system, individual advisors to a team associated with an individual client.

55. **(Withdrawn)** The system of claim 42 wherein the advisor module enables a financial services advisor to use the system for more than one individual client and means for selecting an individual client from among the more than one individual clients.

Appendix B: Evidence Appendix

NONE

Appendix C: Related Proceedings Appendix

NONE